



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,005	08/17/2001	Robert W. Scheifler	6502.0113-01	2982

22852 7590 07/12/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 07/12/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,005

Applicant(s)

SCHEIFLER ET AL.

Examiner

Etienne P LeRoux

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6, 8-11.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Nonstatutory Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 28 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 10/408,365.

Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of copending Application No. 10/408,365. The "resource locator" of instant invention is a slightly narrower than the "object" of copending Application No. 10/408,365. This difference is not sufficient to render the claims patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2171

Claims 28-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 28 recites "returning a resource locator to the client from the lookup service so that the client may dynamically load executable code to facilitate access of the one network service." The specification does not enable one of ordinary skill in the art to make and use the invention because "executable code" is not supported in the specification.

Claims 29-36 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-33, 37-41, 43-51 and 55-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Java-Centric Distributed Computing authored by Ann Wollrath, Jim Waldo and Roger Riggs (hereafter Wollrath), as best examiner is able to ascertain.

Claims 28, 37, 44, 45, 46 and 55:

Wollrath discloses:

- receiving a request from a client by the lookup service for access to one of the network services, the client being remote with respect to the lookup service [Downloading code]; and

Art Unit: 2171

- returning a resource locator to the client from the lookup service so that the client may dynamically load executable code to facilitate access of the one network service [Downloading code].

Claims 29, 38, 47 and 56:

Wollrath discloses using the returned resource locator to dynamically load executable code to facilitate access of the one network service [Downloading Code].

Claims 30, 39, 48 and 57:

Wollrath discloses accessing the network service by the client using the dynamically loaded executable code [Downloading Code]

Claims 31, 49 and 58:

Wollrath discloses wherein the step of returning a resource locator includes the step of returning stub information to the client [Downloading Code].

Claims 32, 40 and 50:

Wollrath discloses using the resource locator in the client to dynamically load executable code for the stub [Downloading Code].

Claims 33, 41, 43, 51 and 59:

Wollrath discloses accessing the network service by the client using the dynamically loaded executable code [Downloading Code]

Claims 28, 37, 44-46 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Proxies, Application Interfaces, and Distributed Systems authored by Amitabh Dave, Mohlalefi Sefika and Roy H Campbell (hereafter Dave) as best examiner is able to ascertain.

Claims 28, 37, 44, 45, 46 and 55 :

Dave discloses:

Art Unit: 2171

- receiving a request from a client by the lookup service for access to one of the network services, the client being remote with respect to the lookup service [5.1 RPC Implementations]; and
- returning a resource locator to the client from the lookup service so that the client may dynamically load executable code to facilitate access of the one network service [5.1 RPC Implementations].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36, 42, 52-54, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wollrath in view of US Pat No 6,018,619 issued to Allard et al (hereafter Allard), as best examiner is able to ascertain.

Claims 34, 42, 52 and 60:

Wollrath discloses the elements of claim 28 as noted above.

Wollrath fails to disclose wherein the step of returning a resource locator includes the step of returning smart proxy information to the client.

Allard discloses wherein the step of returning a resource locator includes the step of returning smart proxy information to the client [col 7, lines 21-35].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wollrath to obtain wherein the step of returning a resource locator includes the step of returning smart proxy information to the client.

Art Unit: 2171

The ordinarily skilled artisan would have been motivated to modify Wollrath per the above for the purpose of preparing an usage tracking object [col 7, lines 20-25].

Claims 35 and 53:

The combination of Wollrath and Allard discloses using the resource locator in the client to dynamically load executable code for a smart proxy [Wollrath: Downloading Code, Allard: col 7, lines 12-35].

Claims 36, 54 and 61

The combination of Wollrath and Allard discloses accessing the network service by the client using the dynamically loaded executable code [Wollrath: Downloading Code, Allard: col 7, lines 12-35].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

July 1, 2004

